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EXAMINER	
GLASS, RUSSELL S	

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/005,695	ENOS ET AL.	
	Examiner	Art Unit	
	Russell S. Glass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 17-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11 and 17-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. The objections to claim 16 are withdrawn based on Applicant's cancellation of the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

2. The previous rejections to claims 1-17 are withdrawn based on Applicant's amendments, including cancellation of claims 12-16.

3. **Amended claims 2, 3, and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

4. As per claim 2, the amended language contains two instances of "selected from the group consisting of". It is unclear whether the claim requires an item to be selected from the first group and from the second group, or whether the items in the second group can be selected without first selecting an item from the first group.

5. As per claims 3 and 4, it is unclear how the added limitation of a pre-printed prescription pad can be previewed because the pre-printed pad, as per claim 1, has already been generated.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-11, 17-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayaud, (U.S. 5,845,255).**

7. As per claim 1, Mayaud discloses a method of providing medical prescription service, the method comprising:

receiving, on a computer, a medical group formulary for a physician within the medical group wherein the formulary is stored in a data store on the computer, (Mayaud, col. 8, lines 1-32)(disclosing a physician receiving information from a data list of formularies);

deriving a physician specific formulary from the medical group formulary, (Mayaud, col. 8, lines 1-32)(disclosing a personalization of the screen that is considered to be physician-specific); and

generating a personalized physician-specific pre-printed prescription pad using the derived formulary, (Mayaud, col. 7, lines 30-67; col. 8, lines 1-32; col. 9, lines 65-67, col. 12, lines 35-56))(disclosing an adaptive method for receiving a formulary and generating a personalized physician-specific prescription pad from the formulary information).

8. As per claim 2, Mayaud discloses a method as defined in claim 1 wherein said received formulary is derived from information, the information comprising information selected from a group consisting of: the physician specific formularies of other physicians in the medical group, the formularies of at least one health insurance company, the formulary of at least one managed care organization, information regarding the likelihood of approval of a drug by at least one health insurance company, and where the derived physician specific formulary is derived from the received formulary and information comprised of information selected from a group consisting of: information regarding the physicians prescribing habits, information regarding the physicians patient base, information regarding the physician's preferences, and information regarding the physicians practice area, (Mayaud, col. 5, lines 33-43, 48-50, 62-64; col. 7, lines 13-45; col. 8, lines 1-32; col. 9, lines 65-67; col. 12, lines 35-56; col. 13, lines 13-18, 40-44) (disclosing an adaptive method for receiving a formulary and

automatically generating a personalized physician-specific prescription pad screen, taking into account the patterns and habits of a regular user, such as frequently used information, drugs, conditions patients or patient groups).

9. As per claim 3, Mayaud discloses a method further comprising: providing a preview of the pre-printed prescription pad on the computer, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21).

10. As per claim 4, Mayaud discloses a method wherein the preview of the pre-printed prescription pad is provided to thecomputer over a network connection, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21).

11. As per claim 5, Mayaud discloses a method wherein the formulary is received by the computer over a network connection, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21).

12. As per claim 6, Mayaud discloses a method further comprising: sending a message to a user informing the user of the generation of the pre-printed prescription pad, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21)(see specifically prescribing zone 44 wherein virtual prescription pad is virtually generated and displayed, thus effectively sending a message informing a user of said generation of said prescription pad).

13. As per claim 7, Mayaud discloses a method further comprising: receiving, on the computer, an approval of the generated personalized pre-printedprescription pad, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21)(send Rx button for output to pharmacy or printer is a method of receiving approval from user).

14. As per claim 8, Mayaud discloses a method further comprising:
receiving on the computeran alert-triggering information that relates to the formulary listed in the generated pre-printedprescription pad, (Mayaud, col. 23, lines 19-39).

15. As per claim 9, Mayaud discloses a method further comprising:
sending an alert communication to a user based on the alert-triggering information, (Mayaud, col. 23, lines 19-39).

16. As per claim 10, Mayaud discloses a method wherein the alert communication indicates that said personalized pre-printed prescription pad previously generated for the physician should be updated, (Mayaud, col. 15, lines 48-52; col. 20, lines 32-36; col. 23, lines 19-39)(disclosing a method of automatically updating and/or requiring that the personalized prescription pad be updated because the system prevents prescribing an drug subject to an alert communication).

17. As per claim 11, Mayaud discloses a method further comprising:

creating a new personalized pre-printed prescription pad for the physician based on the alert-triggering information, (Mayaud, col. 15, lines 48-52; col. 20, lines 32-36; col. 23, lines 19-39).

18. As per claim 17, Mayaud discloses a method further comprising:

(a) receiving, on the computer, information related to prescriptions filled for the physician, (Mayaud, col. 13, lines 25-47); and

(b) generating a prescription analysis for the physician, (Mayaud, col. 13, lines 25-47) (reporting functions are considered to be analysis).

19. As per claim 18, Mayaud discloses a computer system that provides medical prescription services to physicians, the system comprising:

an RxIQ Datamart that stores, processes, collects, and combines formulary information, including formulary for physicians, medical groups, and managed care organizations, and user information, (Mayaud, col. 46, lines 23-31; col. 47, lines 29-46)(host computer facility is equivalent to an RXIQ Datamart because it performs an identical function in substantially the same way and produces substantially the same results),

a Prescriber Portal that enables users to provide formularies and physician-specific information, including prescribing habits, that are then stored in said RxIQ Datamart, (Mayaud, col. 7, lines 30-45; col. 8, lines 1-9); and

an eScriptPad Configurator that creates personalized physician-specific prescription pad called eScriptPad based on formularies and physician-specific information available, wherein the physician-specific information comprises information selected from a group consisting of: information regarding a formulary derived for a medical group, the physician being part of the group, the physician specific formularies of other physicians in the medical group, the formularies of at least one health insurance company, the formulary of at least one managed care organization, information regarding the likelihood of approval of a drug by at least one health insurance company, information regarding the physicians prescribing habits, information regarding the physicians patient base, information regarding the physician's preferences, and information regarding the physicians practice area, (Mayaud, col. 5, lines 33-43, 48-50, 62-64; col. 7, lines 13-45; col. 8, lines 1-32; col. 9, lines 65-67; col. 12, lines 35-56; col. 13, lines 13-18, 40-44) (disclosing an adaptive method for receiving a formulary and automatically generating a personalized physician-specific prescription pad screen, taking into account the patterns and habits of a regular user, such as frequently used information, drugs, conditions patients or patient groups).

20. As per claim 19, Mayaud discloses a system wherein the eScriptPad Configurator enables a user to preview the eScriptPad prescription pad and enables revisions and inputs to said prescription pad, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21).

21. As per claim 20, Mayaud discloses a system wherein the preview of eScriptPad prescription pad is provided over a computer network connection, (Mayaud, Fig. 3, col. 19, lines 4-col 21, line 21; col. 46, lines 1-5).

22. As per claim 21, Mayaud discloses a system wherein the user input and revisions are received over a computer network data connection, (Mayaud, col. 45, lines 35-47).

23. As per claim 22, Mayaud discloses a system further comprising: an Rx Alert Service that receives alert-triggering information and sends alert-triggering communication to the appropriate user, (Mayaud, col. 23, lines 19-39).

24. As per claim 23, Mayaud discloses a system wherein said alert-triggering communication indicates that an eScriptPad prescription pad created by said eScriptPad Configurator needs to be updated, (Mayaud, col. 15, lines 48-52; col. 20, lines 32-36; col. 23, lines 19-39)(disclosing a method of automatically updating and/or requiring that the personalized prescription pad be updated because the system prevents prescribing an drug subject to an alert communication).

25. As per claim 24, Mayaud discloses a system further comprising:
a DecisionIQ Prescription Analyzer that processes information retrieved from the RxIQ Datamart and generates reports, (Mayaud, col. 13, lines 19-47).

26. As per claim 25, Mayaud discloses a system wherein said report is a prescription exception report, (Mayaud, col. 12, lines 34-col. 13, line 12; col. 36, lines 1-65)(user-adaptive reporting functions contain information is equivalent to a prescription exemption report because it performs an identical function in substantially the same way and produces substantially the same results, i.e., it reports whether of not the user prescribed a formulary drug).

27. As per claim 26, Mayaud discloses a computer system that provides medical prescription services to physicians, the system comprising:

(a) a computing means that receives input from network nodes, (Mayaud, col. 46, lines 23-31; col. 47, lines 29-46);

(b) a store and processing means that stores, processes, collects, and combines formulary information, including formulary for physicians, medical groups, and managed care organizations, and user information, (Mayaud, col. 46, lines 23-31; col. 47, lines 29-46),

(c) an input receiving means that enables users to provide formularies and physician-specific information, including prescribing habits, that are then stored in said RxIQ Datamart, (Mayaud, col. 8, lines 1-9, 24-33, col. 45, lines 35-47); and

(d) a pad configuration means that creates personalized physician-specific pre-printed prescription pad called eScriptPad based on formularies and physician-specific information available wherein the physician-specific information comprises information selected from a group consisting of: information regarding a formulary derived for a

medical group, the physician being part of the group, the physician specific formularies of other physicians in the medical group, the formularies of at least one health insurance company, the formulary of at least one managed care organization, information regarding the likelihood of approval of a drug by at least one health insurance company, information regarding the physicians prescribing habits, information regarding the physicians patient base, information regarding the physician's preferences, and information regarding the physicians practice area, (Mayaud, col. 5, lines 33-43, 48-50, 62-64; col. 7, lines 13-45; col. 8, lines 1-32; col. 9, lines 65-67; col. 12, lines 35-56; col. 13, lines 13-18, 40-44) (disclosing an adaptive method for receiving a formulary and automatically generating a personalized physician-specific prescription pad screen, taking into account the patterns and habits of a regular user, such as frequently used information, drugs, conditions patients or patient groups).

28. As per claim 27, Mayaud discloses a pre-printedphysician-specific prescription pad based from a process in which a formulary for a physician is received and wherein said formulary takes into account the physician's prescribing habits, the formularies of managed care organizations (MCOs) across the physician's patient base, the drugs within the MCO formulary which are likely to be approved by the MCO, and the formulary of the medical groups to which the physician belongs, (Mayaud, col. 5, lines 40-48, col. 7, lines 13-20; col. 8, lines 1-8, 24-33; col. 9, lines 65-67).

29. As per claim 28, Mayaud discloses modifying a previously generated prescription pad, (Mayaud, col. 8, lines 34-48)(disclosing the creation of a chronologically current prescription pad version that is considered to be modifying a previously generated prescription pad).

30. As per claim 29, Mayaud discloses a user selected from a group consisting of a physician, a medical provider, a medical group, a medical group administrator, a managed care organization, a payer, an insurance group, a drug company, a pharmaceutical company, an independent practice association, and a pharmacy, (Mayaud, col. 7, lines 15-20).

Response to Arguments

Applicant's arguments filed July 27, 2006 have been fully considered but they are not persuasive for the following reasons:

1. In response to applicant's argument that Mayaud fails to teach "deriving a physician specific formulary from the medical group formulary", it is submitted that Mayaud teaches that a user can be a single physician and/or a prescribing organization, i.e. a medical group, (Mayaud, col. 7, lines 15-20). Mayaud further discloses that the formulary can be derived from data resources of a patient's historical healthcare providers, (Mayaud, col. 8, lines 21-23). If a new physician to a medical group treated a patient that had been a patient of that medical group prior to treatment, then a formulary

would be derived for the new physician based on data resources of the patients historical healthcare providers, i.e., the medical group formulary.

2. In response to applicant's argument that Mayaud fails to teach "a preprinted prescription form", it is submitted that Mayaud teaches printing a hard paper copy of a prescription, (Mayaud, col. 9, lines 47,48; col. 15, lines 39, 40; col. 27, lines 31-35).

3. In response to applicant's argument that Mayaud fails to teach elements related to physician specific information added by amendment to claims 2, 18 and 26, it is submitted that such information is non-functional descriptive material that fails to further limit the scope claims beyond the disclosure of Mayaud, (see MPEP 2106).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RSG
10/14/06

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER